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Maria Theresa Barnes Leon

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CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN, TX 78758

EXAMINER

CHUMPITAZ, BOB R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,011	Applicant(s) LEON ET AL.	
	Examiner BOB CHUMPITAZ	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a Non-Final Office Action in response to application filed December 9, 2008. Claims 1-3 and 10-19 have been amended. Claims 1-24 are pending and are presented for examination on the merits.

Response to Amendments

In light of Applicant's amendment to the specification, the Examiner withdraws the specification objection.

Claim Objections

Claims 4 and 13 are objected to because of the following informalities:

As per claims 4 and 13, recites: "which include other elements". It is unclear and indefinite to what applicant intends to include as the "other elements". Appropriate clarification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20, is directed towards the statutory category of a system and recites: "a data structure wherein...". However, the body of claim 20 comprises one or more employee position elements, and is thus directed towards function descriptive material. Therefore, it is not clear how a series of "elements" (or functional descriptive material) constitutes a system. Clarification is required. For examination purposes, the Examiner is interpreting the system to contain a combination of software and hardware elements.

Claims 21-24 depend from claim 20 and contain the same deficiencies. Therefore, claims 21-24 are also rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his/her invention. Clarification is required. For examination purposes, the Examiner is interpreting the system to contain a combination of software and hardware elements

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Mui et al. (US 2003/0229529 A1, hereinafter Mui).

As per claim 19, Mui discloses a system, comprising:

a central processing unit (CPU) ([paragraph] [0220] business application platform system, where the general purpose system includes one or more central processing units); a memory, coupled to the CPU, the memory (Fig. 2 Memory 211) further comprising
a data structure *for* managing employee data, wherein
the data structure comprises a list of employee positions element for defining a hierarchy of data elements, the hierarchy of data elements includes a plurality of employee position elements ([0268, 271, 292, 293, 330] data structure).

The Examiner notes, with respect to system claims 19-24. Mui discloses the CPU and the memory structure. Mui teaches various forms of data storage for it's system (i.e. disk storage unit 223 and CD-ROM medium [0220]). Furthermore, the specific use of the invention and/or any steps set forth in the claims are not given patentable weight. In fact, the claims do not recite any additional structural apparatus elements other than those discussed above. The other recitations of the claims recite various steps comprising a list of employee position elements. The patentability of an apparatus claim depends on the claimed structure, not on the use or purpose of that structure, *Catalina Marketing Int'l Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002), or the function or result of that structure. *In re Danly*, 263 F.2d 844, 848, 120 USPQ 528, 531 (CCPA 1959); *In re Gardiner*, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948). It follows then that if a prior art apparatus possesses all of the claimed structural characteristics, including the capability of performing the claimed function, then there is a prima facie case of unpatentability. See *In re Ludtke*, 441 F.2d 660, 663-

64, 169 USPQ 563, 566-67 (CCPA 1971). For this recitation and general proposition.

See *Ex Parte Seaver et al.*

Furthermore, several claims are directed to nonfunctional descriptive material and is not functionally involved in the steps recited. This nonfunctional descriptive material *in a system claim is not given patentable weight, and even when recited in a method claim, will not distinguish the claimed invention from the prior art in terms of patentability* See *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01. Applicant is directed to review this section of the MPEP when considering the limitations of any newly amended or drafted method claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui in view of Peterson (US 7,099,350).

As per claims 1 and 10, Mui discloses a method in a computing system, the method comprising: managing employee data ([0003, 123] manage entities within a business, which includes employees, clients, companies, departments, and business units), and a computer-readable

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storage medium carrying one or more sequences of instructions for managing employee data ([0220] business application platform system, where the general purpose system includes one or more central processing units), wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform:

wherein the managing comprises:

extracting, using the computing system, employee position management information in a first form that is associated with a first source computerized employee position management system ([1209] the SABA interconnect backplane can access the new employee data via XML; see also [0857-858] accessor 935 and importer 940; see also Claim 19: job position profile record representing the person's job position, wherein the job position profile record identifies required competencies and associated required competency level);

converting, using the computing system, the employee position management information in the first form into employee position management information that is in a second intermediate form ([1209] employee data via XML, the interconnect server performs style sheet transformation to convert the XML into the platform's native format and transmit the data to the business server which then updates the database management system; see also, [0737] the role of the view style is to convert the XML document to a format document understood by the user agent; see also [0857, 0893] the accessor 935 is used to extract objects from the source representation and convert them to a interchange format); and

Mui does not expressly disclose converting, using the computing system, the employee position management information in the second intermediate form into employee position management information in a target form that corresponds to a target computerized employee position management system.

However, Peterson teaches a method for transferring information between first and second systems with dissimilar first and second database structures (col. 3, lines 15-29 method includes the step of first extracting data from the first system and then routing the extracted data from the first system to a first conversion server....at the first conversion server data is converted from a format compatible with the first database structure to an intermediate format....the intermediate format is then routed to a second conversion server....at the second conversion server data is converted from the intermediate format to a format compatible with the second database structure....the data converted at the second conversion server is then stored in the second system).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method for managing application processes, which include an AccessorReader, of Mui to include the method for transferring information as taught by Peterson in order to provide a system

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architecture which allows for transmitting data in a data processing system efficiently and cost effectively.

As per claims 2 and 11, Mui further discloses using the employee position management information in the target form to perform at least one computer-implemented act from a set of computer-implemented acts and a computer-readable storage medium ([0220] memory section 209, CD-ROM medium 219) comprising:

creating a new employee position management record in the target computerized employee position management system ([0127] profile manager; [0230] the persistence framework defines a common code path used to create new objects, restore and update existing objects, delete objects and find objects; [0234] creating a new employee; [1209] new employee is added and Claim 19: job position profile); and

updating an existing employee position management record in the target computerized employee position management system ([0004] constantly updating and advancing the skills and performance of the company's workforce; [0205-208] SABA performance manages profile metadata that describes individual and group goals, competencies and development plans and the Learning Object metadata updates the profile metadata; [0230] update existing objects).

As per claims 3 and 12, Mui discloses:

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extracting, using the computing system, employee position management information in a third form that is associated with a second source computerized employee position management system that is distinct from the first source computerized employee position management system ([1209] the SABA interconnect backplane can access the new employee data via XML; [0857-858] accessor 935 and importer 940; Claim 19: job position profile record representing the person's job position, wherein the job position profile record identifies required competencies and associated required competency level; [0880] the AccessorReader is responsible for extracting the required object on the information passed in Local Object);

converting, using the computing system, the employee position management information in the third form into employee position management information that is in the second intermediate form ([1209] employee data via XML, the interconnect server performs style sheet transformation to convert the XML into the platform's native format and transmit the data to the business server which then updates the database management system; see also, [0737] the role of the view style is to convert the XML document to a format document understood by the user agent; see also [0857, 0893] the accessor 935 is used to extract objects from the source representation and convert them to a interchange format); and

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Mui does not expressly disclose converting, using the computing system, the employee position management information in the second intermediate form into employee position management information in the target form; and

However, Peterson teaches a method for transferring information between first and second systems with dissimilar first and second database structures (col. 3, lines 15-29 method includes the step of first extracting data from the first system and then routing the extracted data from the first system to a first conversion server....at the first conversion server data is converted from a format compatible with the first database structure to an intermediate format....the intermediate format is then routed to a second conversion server....at the second conversion server data is converted from the intermediate format to a format compatible with the second database structure....the data converted at the second conversion server is then stored in the second system).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method for managing application processes, which include an AccessorReader, of Mui to include the method for transferring information as taught by Peterson in order to provide a system architecture which allows for transmitting data in a data processing system efficiently and cost effectively.

Mui further discloses using the employee position management information in the target form to perform at least one computer-implemented act from a set of computer-implemented acts comprising:

creating a new employee position management record in the target computerized employee position management system ([0127] profile manager; [0230] the persistence framework defines a common code path used to create new objects, restore and update existing objects, delete objects and find objects; [0234] creating a new employee; [1209] new employee is added and Claim 19: job position profile); and

updating an existing employee position management record in the target computerized employee position management system ([0004] constantly updating and advancing the skills and performance of the company's workforce; [0205-208] SABA performance manages profile metadata that describes individual and group goals, competencies and development plans and the Learning Object metadata updates the profile metadata; [0230] update existing objects).

Claims 4-9 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui in view of Peterson and in further view of Kurzius et al. (US 6,385,620 B1, hereinafter Kurzius).

As per claims 4 and 13, as best understood, Mui and Peterson disclose claim 1 as rejected above, but do not expressly disclose wherein the second intermediate form includes a list of

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employee positions element for defining a hierarchy of data elements, wherein the hierarchy of data elements includes a plurality of employee position elements, which include other elements.

However, Mui teaches job definitions and required competencies which the jobholder must possess for the organization [1232]. In addition, Kurzius teaches a hierarchical structure that may be used within an index of job postings (col. 10, lines 53-67 and Fig. 17). In addition, Kurzius teaches a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (Fig. 18). Furthermore, Kurzius teaches a filter engine used for determining if a candidate that a predetermined number of years experience (col. 8, lines 1-6), and a candidate matching engine operable to match candidate records to job posting records using matching algorithms and/or listed hierarchies of matching criteria (col. 8, lines 28-40). Lastly, Kurzius teaches selectable freeform fields where candidates may indicate education and work history (col. 16, lines 38-56).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the job definitions of Mui and the method for transferring information as taught by Peterson to include a list of candidate skills as taught by Kurzius in order to ensure that all employee elements are met and it would also be beneficial to provide a hierarchy structure used within a job index in order to prioritize the most important job position elements within a job category.

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As per claims 5 and 14, The Mui/Peterson/Kurzius combination disclose claims 4 and 13 as rejected above, where Mui further discloses a job type id, job title and requirements ([1241, 1245]) but does not expressly disclose wherein each of the plurality of employee position elements includes **one or more** elements selected from a group comprising:

a position identifier; a position base data element; a position related division element; a position related organization element; a related parent position element; and a position custom data element.

However, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18). Lastly, Kurzius teaches job posting identifiers (col. 11, lines 12-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the job type requirement of Mui and the method for transferring information as taught by Peterson to include job posting identifier as taught by Kurzius in order to effectively identify and track the job position and the plurality of employee position elements within a job position.

As per claims 6 and 15, it recites equivalent limitations to claim 5 and 14 and are, therefore rejected using the same art and rationale as set forth above.

As per claims 7-9 and 16-18, “wherein the position related division element includes a position related division identifier; wherein the position related organization element includes a position related organization identifier; wherein the related parent position element includes a related parent position identifier”

The Examiner notes, As per claim 5 “wherein each of the plurality of employee position elements includes **one or more** elements...”. This phrase is a conditional limitation. The noted steps in claims 7-9 are not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

[See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 11 61 (Fed. Cir. 1991); MPEP 2106 II C].

Furthermore, with respect to claims 7-9: Mui discloses a job type id, job title and requirements [1241, 1245], however fails to disclose the specific position element categories. However the specific types of categories, is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The extracting, converting, creating and updating steps would be performed the same regardless of what type of categories they belong to. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui in view of Kurzius.

As per **claim 20**, Mui discloses a job type id, job title and requirements ([1241, 1245]) but does not expressly disclose wherein each of the plurality of employee position elements includes **one or more** elements selected from a group comprising:

a position identifier; a position base data element; a position related division element; a position related organization element; a related parent position element; and a position custom data element.

However, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18). Lastly, Kurzius teaches job posting identifiers (col. 11, lines 12-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the job type requirement of Mui to include job posting identifier as taught by Kurzius in order to effectively identify and track the job position and the plurality of employee position elements within a job position.

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As per claim 21, it recites equivalent limitations to claim 20 and is, therefore rejected using the same art and rationale as set forth above.

As per claims 22-24, “wherein the position related division element includes a position related division identifier; wherein the position related organization element includes a position related organization identifier; wherein the related parent position element includes a related parent position identifier”.

The Examiner notes, As per claim 20 “wherein each of the plurality of employee position elements includes **one or more** elements....”. This phrase is a conditional limitation. The noted steps in claims 7-9 are not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

[See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 11 61 (Fed. Cir. 1991); MPEP 2106 II C].

Response to Arguments

In light of new grounds of rejections, arguments are moot.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within

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the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOB CHUMPITAZ whose telephone number is (571)270-5494. The examiner can normally be reached on M-TR: 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6494.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. C.
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629